



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,081	02/04/2004	Michael Shane Croft	60213 (50211)	6035
21874 7590 06/24/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
NGUYEN, THUY-VI THI				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
06/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/773,081

**Applicant(s)**

CROFT ET AL.

**Examiner**

THUY-VI NGUYEN

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear of how a seller can guarantee the lessee for the truck when a buyer is the one who leases the truck to the lessee. It was interpreted as the seller guarantees the buyer (not the lessee) for the truck can be leased.

Regarding claim 9, there is lack antecedent basis for step (a) "*the terms of a purchase*". Furthermore, step (a) recites "*.....lease of said 8 truck to a lessee said terms including at least a guarantee from said seller to a buyer to obtain a lessee for said truck.....*", is a lessee of the second term is preferred back to a lessee of the first term. It is interpreted that they are the same lessee.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-8 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

5. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 1-8 are non-statutory since they may be performed within the human mind.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3689

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schloss et al. (US 2002/0065753) in view of Wallace, Jr. (US 2002/0169641). Herein after is referred as Schloss and Wallace.

**Regarding claim 1**, Schloss discloses a method:

a buyer buys the truck from seller [...i.e. finance company/buyer purchase the motor vehicle (i.e. heavy trucks) from manufacture/seller; par. 0003]

the buyer leases the truck to a lessee [...lease the motor vehicle/trucks to the customer (lessee); par. 0003].

Schloss does not teach a truck seller guarantees buyer for the truck for a predetermined period;

Wallace, however, explicitly discloses, "guarantor provides a warranty to the landlord/lessor/buyer against default by the renter in exchange for the landlord granting a lease to the renter; abstract; pars 0009; par. 0012; 0023; and figure 2].

It would have been obvious to one of ordinary skill in the art to modify Schloss with the method of buying the truck and lease it back to the lessee to include guarantee the landlord/lessor to obtain a lessee as taught by Wallace in order to ensure the lessor/buyer payment through out the lease term as well as obtaining more profit.

**Regarding claim 2**, Wallace discloses wherein said lessee pays a nonrefundable processing fee payment to the buyer and the buyer leases the truck to the lessee upon receipt of the financial payment and said seller obtains a second lessee if said lessee does not make the financing fee payment [...seller/guarantor is providing a list of lessee par. 0012-0014 and figure 2].

**Regarding claim 3**, Wallace discloses wherein said lessee makes periodic payments to said buyer and if said lessee defaults on said periodic payments, said seller obtains a second lessee for said buyer [pars 0009; par. 0012, par. 0024].

**Regarding claim 4**, The Examiner notes that it is old and well known in the art that the vehicle or trucks be equipped with the GPS system in order to track the location.

**Regarding claim 5**, Wallace discloses a payment process [par. 0023]. The Examiner notes that it is old and well known in the art to include periodic payment wherein said periodic payments are weekly within a system and method of the instant application.

**Regarding claim 6**, Claim 6 parallels the limitations of Claim 5. As such, Claim 6 is rejected under the same basis as is Claim 5 as mentioned supra.

**Regarding claim 7**, The Examiner notes that the type of lease does not hold additional patentable weight and is given very minimal consideration and the type of lease is also a non functional descriptive material.

**Regarding claim 8**, Claim 8 reflects the limitations of Claim 7. As such, Claim 8 is rejected under the same basis as is Claim 7 as mentioned supra. Examiner

notes that it is old and well known in the art that before leasing the product or truck or vehicle or equipment, the contract is obtained between the two parties.

8. **Claims 9-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cho et al (US 2002/0147680) in view of Wallace, Jr. (US 2002/0169641). Herein after is referred as Cho and Wallace.

**Regarding claim 9**, Cho discloses:

causing a server coupled to said database to debit a bank account of said lessee an amount for a non-refundable processing fee [...*electronic payment system (16) charge the tenant/lessee's bank account or credit account* ; par. 0017 and figure 1];

obligating said lessee to pay periodic lease payments [...*determine rent collection date under the predetermined schedule as set forth in the agreement*; figure 2; par. 0020, 0021]

causing a transfer of said period lease payment on a periodic basis from a bank account of said lessee to a bank account of said buyer [...*electronic payment system (16) charge the tenant/lessee's bank account or credit account* ; par. 0017; par. 0022 and figures 1 and 2];

updating said computer data files each time said bank account is debited [...*update the tenant's information in the database if the tenant has paid*; pars. 0021, 0022, 0023; figure 2];

determining if a default has occurred [...i.e. the system notifies the tenant of the tenant's delinquency in payment (step 32); par. 0022 and figure 2];

said server notifying said seller to provide a second lessee if a default of the lease has occurred [...*the intermediate (10) as a seller that provides the leasing information to the lessee* (par. 0012; figure 1). *If the lessee fails to pay the rent for several times, the agreement will be terminated between the intermediate and the tenant (lessee)* (par 0020, 0023 and figure 2). Since the intermediate is a service provider who provide the lessee to the landlord. It is obvious that if the first lessee fails to pay the rent, the intermediate will provide another lessee to the landlord in order to get commission from both parties (lessee and lessor); (pars. 0005, 0006, 0012 and figure 1)].

storing at least one computer data file in a computer database reflecting the terms of a purchase of a class 8 truck/item/goods from a seller and a lease of said class 8 truck/goods/item to a lessee [...i.e. Cho discloses a *lease agreement between the intermediary (10)/seller and the landlord or lessor (12); and a lease agreement between a landlord (12) and the lessee or tenant (14) through the website (20)*; (pars. 0007, 0012-, 0013, 0014, 0015);

Cho does not disclose said terms including at least a guarantee from said seller to a buyer to obtain a lessee for a predetermined period [...*the intermediate is obligated to pay the landlord (buyer or lessor) when collect the rent from the lessee at a predetermine schedule*; pars. 0005, 0006].



Wallace, however discloses the guarantor provides a warranty to the landlord against default by the renter in exchange for the landlord granting a lease to the renter [par. 0009].

It would have been obvious in one of ordinary skill in the art at the time of the invention to modified the house leasing process of Cho to include guarantee the landlord/lessor to obtain a lessee as taught by Wallace in order to ensure the lessor/buyer payment through out the lease term as well as obtaining more profit.

Cho as modified by Wallace discloses the house leasing process between the three parties (seller/intermediate, buyer/landlord, tenant/lessee) as described above. Cho as modified by Wallace does not disclose the truck or vehicle leasing process between seller, buyer, and lessee. However, it would have been obvious to one of ordinary skill in the time of the invention to modify the house leasing process of Cho into the truck leasing process since both of these leasing process are similar.

**Regarding claim 10**, Cho discloses lease payments occurs periodically, for example monthly [0014, figure 2]. The Examiner notes that it is old and well known in the art to include periodic payment wherein said periodic payments are weekly within a system and method of the instant application.

**Regarding claim 11**, The Examiner notes that the type of lease does not hold additional patentable weight and is given very minimal consideration.

**Regarding claim 12**, Cho discloses a leasing contract [figure 1]. Examiner notes that it is old and well known in the art that before leasing the product or truck or vehicle or equipment, the contract is obtained between the two parties.

***Conclusion***

9. .The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
10. The US Patent Publication to Iwase discloses a method for managing a payment between a lessor and a lessee, and to Foess et al. discloses a method for establishing lease agreement terms between a lessee and a lessor for leasing a vehicle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

Art Unit: 3689

assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689